

REMARKS

In the Office Action under reply, claims 1-4, 6-8 and 15-20, all the claims remaining in this reissue continuation, stand rejected on the ground of seeking to recapture claimed subject matter allegedly surrendered during the prosecution of the parent patent. Applicant traverses this rejection and, as will be explained, submits that the "recapture" doctrine is not applicable to the claims of this reissue continuation application.

Summary of the Claims

As compared to the claims issued in U.S. Patent 5,434,677:

Claims 1, 2, 15 and 16 were amended in this application at the time of filing.

Claims 3, 4, 6-8 and 17-20 remain in the same form as issued in original USP 5,434,677.

Claims 5 and 9-14 of the original patent are canceled.

There is No Recapture

Claims 1 and 15, the only independent claims, do not seek to recapture subject matter surrendered during the prosecution of the parent patent. Amendments made in this reissue continuation to original patent claim 1 are proper and are consistent with MPEP §1412.02. The rejection of claim 1 as seeking to recapture subject matter that was disclaimed should be withdrawn and claims 1-4, 6-8 and 15-20 should be found in condition for allowance.

The Examiner correctly notes that claim 1 in the application that issued into the original patent (the "original application") was amended to overcome a rejection under 35 USC 112. In the Office Action mailed October 5, 1994 in the original application, claims 1-20 were rejected under 35 USC 112, second paragraph, because:

"... the functional recitation that ' $\epsilon=0.5$ when said pair of heads ... $\epsilon=0.25$ when said heads are angularly separated by 180°' is indefinite because it is not supported by recitation in the claim of sufficient structure to accomplish the function. How and by what means a pair of heads of a double azimuth head assembly is changed

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to heads which are angularly separated by 180 degree in accordance with the change of ϵ from 0.5 to 0.25."

Clearly, the Examiner in the original application contended that original claim 1 could be construed as requiring a head assembly having heads that are physically movable from a double azimuth assembly to an assembly in which the heads are 180° apart.

To overcome this strained interpretation of claim 1, claim 1 was amended to state that the heads were constructed either as a double azimuth head assembly or as a pair of heads angularly separated by 180°. This amendment surrendered nothing. The proper interpretation of claim 1, as originally filed, meant that the heads were constructed as a double azimuth head assembly, resulting in $\epsilon=0.5$, or with 180° of separation, resulting in $\epsilon=0.25$. The language added to original claim 1 did not narrow the scope of that claim. Rather, the language added to original claim 1 merely clarified and made explicit that which had been claimed all along.

In the present reissue continuation, claim 1 is amended to be broader than original patent claim 1. 35 USC 251 permits this broadening reissue, subject, of course, to the prohibition of seeking to recapture subject matter that was surrendered in order to gain the allowance of the original patent. Here, no structure was added to original patent claim 1 to gain its allowance. As initially filed, claim 1 recited that $\epsilon=0.5$ when the heads are a double azimuth assembly and that $\epsilon=0.25$ when the heads are separated by 180°. Clearly, this meant that the heads were constructed as a double azimuth assembly or with 180° of separation. Consequently, no structural limitations were added to the claim to gain its allowance. Nothing was surrendered. Allowed claim 1 covered the very same subject matter as original claim 1. And, importantly, the recitation added to original claim 1 was submitted to satisfy the rejection based upon 35 USC 112 -- it was not added to overcome an art rejection.

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Claim 1, as presented in the instant reissue continuation, and as rejected in the Office Action under reply, calls for "a pair of rotary heads having respectively different azimuth angles for scanning traces across said magnetic tape." This is the very same language found in original patent claim 1. Consider MPEP §1412.02 I C:

... it must be determined whether the reissue claim entirely omits any limitation that was added/argued during the original prosecution to overcome an art rejection. Such an omission in a reissue claim, even if it includes other limitations making the reissue claim narrower than the patent claim in other aspects, is impermissible recapture. *Pannu v. Storz Instruments Inc.*, supra. However, if the reissue claim recites a broader form of the key limitation added/argued during original prosecution to overcome an art rejection (and therefore not entirely removing that key limitation), then the reissue claim may not be rejected under the recapture doctrine. *Ex Parte Eggert*, 67 USPQ2d 1716 (Bd. Pat. App. & Inter. 2003) (precedential). For example, if the key limitation added to overcome an art rejection was "an orange peel," and the reissue claim instead recites "a citrus fruit peel", the reissue claim may not be rejected on recapture grounds.

The language added to original claim 1 was not added to overcome an art rejection. Claim 1 of the instant reissue continuation still recites "a pair of rotary heads having respectively different azimuth angles for scanning traces across said magnetic tape" and, thus remains as a broader form of the language added to original patent claim 1.

Continuing with MPEP §1412.02 and the discussion following the above-quoted portion, referred to in the MPEP as the discussion "provided for analyzing the reissue claims," attention is drawn to part 2(d), which states:

(d) Reissue Claims Broader in Scope in Area Directed to Amendment/Argument Made to Overcome Art Rejection in Original Prosecution; but Reissue Claims Retain, in Broadened Form, the Limitation(s) Argued/Added to Overcome Art Rejection in Original Prosecution:

Assume the combination AB was originally claimed in the application, and was amended in reply to an art rejection to add element C and thus provide the combination ABC (after which the patent issued). A reissue application is then filed, and the reissue application claims are directed to the combination ABC_{broadened}. The ABC_{broadened} claims are narrowed in scope when compared with the canceled claim subject matter AB, because of the addition of C_{broadened}. Thus,

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the claims retain, in broadened form, the limitation argued/added to overcome art rejection in original prosecution. There is no recapture, since ABC_{broadened} is narrower than canceled claim subject matter AB in an area related to the surrender. This is so, because it was element C that was added in the application to overcome the art. See *Ex Parte Eggert*, supra.

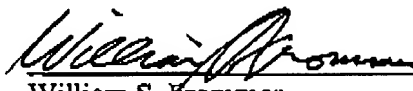
This portion of the MPEP is squarely on point with the present situation, except that here, the language added to original application claim 1 was not added "to overcome an art rejection." Therefore, there is no recapture issue here by deleting from original patent claim 1 the recitation "said heads being constructed either as a double azimuth head assembly or as a pair of heads angularly separated by 180°."

Therefore, it is respectfully requested that the rejection of claims 1-4, 6-8 and 15-20 on the ground of being an improper recapture of subject matter surrendered during the prosecution of the original patent be withdrawn. Since this is the only rejection of the claims; it is further submitted that this reissue continuation is in condition for allowance; and early notice to that effect is respectfully solicited.

Respectfully submitted,

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